

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKASHI OYAMADA

Appeal No. 2001-1266
Application No. 08/966,788

ON BRIEF¹

Before CALVERT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6 to 25, which are all of the claims pending in this application.

We REVERSE.

¹ The oral hearing scheduled for June 13, 2001 was vacated (Paper No. 30, faxed June 4, 2001). In view of this decision, a hearing is not considered necessary. See 37 CFR § 1.194(c), last sentence.

BACKGROUND

The appellant's invention relates to a casing structure of communication equipment used for a wireless communications base station (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 6 to 25 stand rejected under 35 U.S.C. § 101 because the claimed invention is not supported by either a scientific asserted utility or a well established utility.

Claims 6 to 25 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 23, mailed October 2, 2000) for the examiner's complete reasoning

in support of the rejections, and to the brief (Paper No. 22, filed July 24, 2000) and reply brief (Paper No. 24, filed December 18, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The three independent claims on appeal read as follows:

6. A communication equipment comprising: a casing including a base, a cover attached to the base by two hinges that permit the opening and closing of the casing, and at least one electrical component housed within said casing; and a handle of an electrically non-conductive material on said casing, said handle providing electrical insulation of said casing from a messenger wire.

14. A communication equipment suspended from a messenger wire, comprising: a base; a cover attached to the base by two hinges; and a handle of an electrically non-conductive material arranged between and supported by at least part of said hinges.

20. A method of mounting a communication equipment on a messenger wire, said method comprising the steps of: positioning the wire above a non-conductive handle of the

communication equipment; and clamping the messenger wire to the handle using a warped metal plate.

The 35 U.S.C. § 101 Rejection

We will not sustain the rejection of claims 6 to 25 under 35 U.S.C. § 101.

The basis for this rejection (answer, p. 3) is that "[t]he claimed invention lacks patentable utility." However, the examiner has not pointed out how the **claimed** invention (e.g., claims 6, 14 and 20) lacks patentable utility. It is our view that the **claimed** invention clearly has the same well established utility as the known prior art (e.g., Japan Kokai 2-62103 and Japan Kokoku 1-34365).

The examiner (answer, pp. 3-5) has only pointed out how the disclosed invention would have the same problem (electrically conducting state between the communication equipment and the messenger wire) that the known prior art has. Even if this were true, we fail to see how this violates the utility requirement of 35 U.S.C. § 101. Moreover, we agree with the appellant (brief, pp. 3-6) that a person skilled in the art would easily understand from the original

disclosure, as a whole, that the appellant's communication equipment is insulated from the messenger wire due to the electrically insulating handle. Thus, a person skilled in the art would understand that Figure 2 has a clearly evident drawing error (the groove 21 being positioned below the right hinge 13 which would result in the messenger wire C contacting the right hinge 13).

For the reasons set forth above, the decision of the examiner to reject claims 6 to 25 under 35 U.S.C. § 101 is reversed.

The 35 U.S.C. § 112, first paragraph, Rejection

We will not sustain the rejection of claims 6 to 25 under 35 U.S.C. § 112, first paragraph.

This basis for this rejection (answer, p. 5) is that since the claimed invention is not supported by either a scientific asserted utility or a well established utility for the reasons set forth in the rejection under 35 U.S.C. § 101,

one skilled in the art clearly would not know how to use the claimed invention.

For the reasons set forth above in our discussion of the rejection under 35 U.S.C. § 101, it is our view that the **claimed** invention has a well established utility. Accordingly, the decision of the examiner to reject claims 6 to 25 under 35 U.S.C. § 112, first paragraph, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6 to 25 under 35 U.S.C. §§ 101 and 112, first paragraph, is reversed.

REVERSED

IAN A CALVERT)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 2001-1266
Application No. 08/966,788

Page 9

FOLEY & LARDNER
3000 K STREET NW
SUITE 500
WASHINGTON, DC 20007-8696

Appeal No. 2001-1266
Application No. 08/966,788

Page 10

JVN/jg